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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/837,044	04/18/2001	Jean-Marie Vau	81000DAN	9196

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EXAMINER

STRANGE, AARON N

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 03/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/837,044

Applicant(s)

VAU, JEAN-MARIE

Examiner

Aaron Strange

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 12/27/2004 have been fully considered but they are not persuasive.

2. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Applicant merely states that "Neither Seattle FilmWorks not Afifi et al. discloses this problem, or a means to solve it" (Page 7, Lines 3-4). Applicant argues that certain features are not disclosed by Seattle FilmWorks, which the Examiner acknowledged in the Office action of 9/24/2004.

However, the claims were rejected under 35 USC 103(a) over Seattle FilmWorks since the Applicant has not disclosed that the unique terminal identifier provides an advantage, is used for a particular purpose, or solves a stated problem. The terminal identifier is simply used as a means for identifying a customer and forming the URL where their images are located and the customer number disclosed by Seattle FilmWorks performs equally well for this purpose. Therefore, Applicant has failed to persuasively traverse this rejection.

3. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies

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(i.e., prevent everyone, *other than personal of the laboratory*, from having access to the message service address indicated on an order sent to the laboratory by a user of a terminal (Page 7, Lines 16-18)) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Amended claim 1 recites "making at least one digital image available to a user on a server *without a message service address of the user being accessible* (emphasis added). That limitation, as currently recited, does not allow laboratory personnel, or anyone else, to access the message service address. Furthermore, no limitation in the claim recites or implies that a message service address is sent to the laboratory by a user of a terminal.

4. While Applicant's arguments are not persuasive, in light of Applicant's remarks and the amendments to the claims, new grounds of rejection have been presented.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one

skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

7. With regard to claim 1, the limitation “making at least one digital image available to a user on a server without a message service address of the user being accessible” is not described in the specification. The specification fails to state that the message server address is not accessible. The sections cited by Applicant as alleged support for this amendment (Page 1, Lines 27-30; Page 2, Lines 4-10; and Page 3, lines 2-4) state only that the message service address may be a e-mail address, telephone number, or cellular telephone number, and that an object of the invention is to make digital images available to a user without their *e-mail address* being accessible to anyone other than laboratory personnel.

Furthermore, the specification provides no description of how access to the message service address and/or e-mail address is limited to the laboratory personnel. In fact, no mention of a message service address and/or e-mail address appears outside of the background and summary of the specification, which provide no explanation of how they relate to the claimed invention.

8. All claims not individually rejected are rejected by virtue of their dependency from the above claims.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. With regard to claim 1, the limitation "at the defined address stored on the server" in lines 11-12 is unclear. The Examiner recommends that the claim be amended to recite "at the defined address on the server", consistent with lines 13-14 of claim 1.

12. With regard to claim 1, the limitation "without a message service address of the user being accessible" is unclear. It is unclear what purpose a message service address would serve if it was not accessible by anyone. Based on Applicant's remarks and the specification, this limitation has been interpreted to mean that the "message service address" is not accessible to anyone other than employees of the processing lab and the user of the system.

13. All claims not individually rejected are rejected by virtue of their dependency from the above claims.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 1 and 3-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seattle FilmWorks in view of Lambert et al. (US 6,363,478) in further view of Garfinkle et al. (US 6,017,157).

16. The Office would like to inform Applicant that the collection of references from Seattle FilmWorks, while located in a plurality of separate files, have been treated as a single reference. All of the references are parts of the same website, retrieved from the Internet Archive Wayback Machine, dating from 2/08/1999 to 1/15/2000, and relating to the same subject matter. The reference is very much like multiple chapters in a book, and have accordingly been treated a single reference in this Office action. Alternatively, a rejection under 35 USC 103(a) could be made using the combination of references. Since the pages are all part of the same website and relate to the same subject matter, the motivation to combine them is apparent.

17. With regard to claim 1, Seattle FilmWorks discloses a process for making at least one digital image available to a user on a server without a message service address of

the user being accessible (e-mail address is included with the order, so it will only be accessible to employees of the laboratory and the user) ("FAQ", Page 2, Lines 34-39), the process comprising: receiving a code sent from a terminal by a user via a telephone call or a mobile Internet session which identifies at least one image which is to be processed (Roll number entered at login identifies roll of pictures) ("Login", Lines 5-12), defining an address on the server by integrating a number identifying the customer ("PhotoMail Instruction", Page 2, Lines 3-6); and storing the at least one image at the defined address on the server ("PhotoMail Instructions", Page 2, Lines 3-6). Seattle FilmWorks fails to specifically disclose using a number which uniquely identifies the terminal rather than a customer number or that the at least one digital image is obtained by processing at least one silver image and digitizing the at least one silver image to create said at least one digital image.

Lambert teaches a method of identifying a client terminal by assigning a unique identifier to the terminal when a request for service is made at the server. Subsequent requests include the ID in the URL sent to the server, enabling the server to identify the client terminal (Col 2, Lines 46-67). Using a unique terminal identifier rather than a customer number would have been an advantageous addition to the system disclosed by Seattle FilmWorks since it would have allowed the terminal to be identified automatically and would not have required the customer to input any additional identification information.

Garfinkle discloses obtaining digital images by processing silver images and digitizing the silver images to create the digital images (Col 1, Lines 17-55 and Col 2,

Lines 53-64). This procedure is likely the same as the procedure used by Seattle FilmWorks when processing the rolls ("Login", Lines 6-13), despite the lack of detail. Nonetheless, this would have been an advantageous way to take obtain digital images for storing on the server.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system disclosed by Seattle FilmWorks to obtain the invention as specified in claim 1, in view of the teachings of Lambert and Garfinkle.

18. With regard to claim 3, Seattle FilmWorks further discloses that the code identifying said at least one image is a number associated with a support on which said at least one image to be processed is found (Roll Number) ("Login", Lines 5-12).

19. With regard to claim 4, Seattle FilmWorks further discloses that said at least one image to be processed is a digital image (digital files can be sent in for processing) ("FAQ", Page 3, Lines 8-12).

20. With regard to claims 5-7, while the system disclosed by Seattle Filmworks in view of Lambert and Garfinkle shows substantial features of the claimed invention (discussed above), it fails to specifically disclose that the code identifying the at least one image to be processed is a number of an APS cartridge, a number of an envelope

into which is inserted a film support, or a number identifying the place where the envelope was handed in by the user.

However, the choice of one of these sources for the code to identify the at least one image to be processed would merely be a design choice for one of ordinary skill in the art. These different code sources all uniquely identify the at least one image, ensuring that images are not confused with one another.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use any unique identifier for the at least one image to be processed so that images are not confused with one another.

21. Claims 2 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seattle FilmWorks in view of Lambert et al. (US 6,363,478) in further view of Garfinkle et al. (US 6,017,157) in further view of Afifi et al.

22. With regard to claims 2 and 8, while the system disclosed by Seattle FilmWorks in view of Lambert and Garfinkle shows substantial features of the claimed invention (discussed above), it fails to specifically disclose that the receiving step comprises automatically recovering, during the call or the mobile Internet session, the user's telephone number or automatically identifying the place where the telephone call or mobile Internet session is coming from.

Afifi teaches the use of a telephone number to identify a system user (Section

2.1). A telephone number is a simple means for identifying a customer since each customer typically has a different telephone number, especially in the case of a mobile phone. Identifying the place (number) where the call originated from and using the customer's telephone number to identify them provides a simple identification means that does not require the customer to remember additional information.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to determine what number the telephone call or mobile Internet session originates from and using this information to identify the customer, since it provides an easy to remember means for the customer to be identified.

Conclusion

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

24. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Strange whose telephone number is 571-272-3959. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AS 3/8/2005



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